

REMARKS

The Office Action dated June 4, 2003, has been received and carefully considered.

Claims 9-32 and 41-46 are pending in the present application.

Applicants respectfully request reconsideration of claims 9-32 and 41-46 in view of the following remarks.

I. THE OBVIOUSNESS REJECTION OF CLAIMS 9, 15, 24, 41 and 43

At paragraph 12 of the Office Action, claims 9, 15, 24, 41 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruffin et al. (U.S. 6,249,769) in view of Dan et al. (U.S. 6,560,639). As each of remaining claims in the present application are dependent from these claims, Applicants will restrict their argument to these claims. This rejection is hereby respectfully traversed.

A. Basic Requirement for Prima Facie Case of Obviousness

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings

of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

B. The Examiner’s Argument for Obviousness

The Examiner states that Ruffin discloses a system and method for evaluating, planning and implementing a business project. Office Action, pg. 5, ¶12. With respect to claims 9, 15, 24, 41 and 43, the Examiner admits that, “Ruffin et. al does not teach contingency plans for errors, document information in table form or using performance factors to measure implementation of a project.” Office Action, pg. 6, ¶12. The Examiner, however, cites Dan as teaching these elements steps and concludes:

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al. invention with the additional documentation specific function of Dan et al because documentation and the ability to manipulate documents be it electronic or print is an essential component of any business system. The ability to store, change, reformat and save documents related to a project is necessary in order to communicate technical, projected related concepts between the technical person on a project team and the business people on the projected planning and conception side of a project. The great advantage to adding the document manipulation aspects to the project management invention is to foster increased communications between technical and business persons while increasing [the] accuracy of said communications by creating a more detailed audit trail for a project.

Office Action, pg. 9, ¶2.

C. Applicants' Argument Regarding Claims 9, 15, 24, 41 and 43.

Respectfully, the Examiner has failed to identify a specific teaching or suggestion to make the claimed combination. Additionally, the Examiner has failed to show prior art which suggests a reasonable expectation of success in making the claimed combination.

1. The Examiner has Failed to Establish a Prima Facie Case of Obviousness.

The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner admits that Ruffin fails to disclose the use of contingency plans for error correction, the use of a system for providing document information in table form, or the use of performance factors to measure implementation of a project. Office Action, pg. 6, ¶#12. The Examiner, however, fails to provide a prior-art reference that teaches, suggests or motivates the use of this step in combination with the additional claimed elements of the Applicants' invention. Instead, the Examiner has argued the combination of Ruffin and Dan based solely on the Examiner's statement that:

The great advantage to adding the document manipulation aspects to the project management invention is to foster increased

communications between technical and business persons while increasing [the] accuracy of said communications by creating a more detailed audit trail for a project.

(Office Action, Page 6, ¶5.)

This reasoning is not permissible.

a. There is No Suggestion to Combine Ruffin and Dan

Between Ruffin and Dan, there exist no adequate teaching or suggestion to specifically modify the teaching of Ruffin to include the use of contingency plans for error correction, the use of a system for providing document information in table form, or the use of performance factors to measure implementation of a project. Any suggestion to suggestion to combine must be found either **explicitly or implicitly** in the references themselves. MPEP § 2143.01. Absent a specific showing by the Examiner of prior art indicating otherwise, the Applicants submit that the combination of steps claimed in claims 9, 15, 24, 41 and 43 were not within the knowledge generally available to one of ordinary skill. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

b. There is No Reasonable Expectation of Success Demonstrated in the Prior Art.

The Applicants do agree with the Examiner that the Applicant's invention does provide a great advantage over the prior art and that it does "foster increased communications between technical and business persons while increasing [the] accuracy of said communications by creating a more detailed audit trail for a project." (Office Action, Page 6, ¶5). This benefit was a motivating factor in the Applicants' invention. However, in order to establish a *prima facie* case of obviousness, the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **not** in applicant's disclosure. *In re*

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the present case, the Examiner has provided **no art** which teaches or suggests the desirability of the Applicants' invention.

3. Conclusions Regarding Claims 9, 15, 24, 41 and 43.

Respectfully, the Examiner has failed to identified a specific teaching or suggestion for combining the teachings of Ruffin and Dan to make the claimed combination. Additionally, the Examiner has failed to show prior art which suggests a reasonable expectation of success in making the claimed combination.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 9, 15, 24, 41 and 43 are improper, and the withdrawal of such rejection is respectfully requested.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

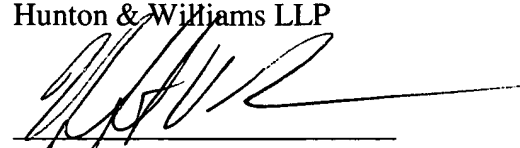
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper,
including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess
fees to the same deposit account.

Respectfully submitted,

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Date: October 6, 2003